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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,526

04/07/2004

Andrew Valdez

VLD 301

8335

7590

09/08/2006

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EXAMINER

ABDELWAHED, ALI F

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/820,526

Applicant(s)

VALDEZ, ANDREW

Examiner

Ali Abdelwahed

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-23 is/are pending in the application.
- 4a) Of the above claim(s) 18-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 18-23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly submitted claims 18-23 disclose a method of mounting hardware on a door through the use of a template to select and mark drilling locations on a door; whereas the originally claimed invention is only directed to a template device.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-12 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations regarding "a third line group

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connecting and identifying a third set of perforations in the template", "perforation diameters are in the range of 1 to 10 millimeters", "each line group includes a label", "the positions of the first set of perforations are congruent with mounting holes of a parallel arm door closer; and the positions of the second set of perforations are congruent with mounting holes of a regular arm door closer", and "the third face includes one or more holes configured to correspond to the position of door fixture mounting holes" are not described in the originally filed specification in any way.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,114,285 to Brydon in view of U.S. Patent No. 5,058,285 to Morita et al.

Brydon discloses a door (20) with edges (95) and faces (120), a template (10) configured to straddle a door edge (see fig. 4) comprising first and second spaced apart, aligned, substantially parallel faces (50, 60) with first and second sets of perforations (80). A third perpendicular face (70) with a third set of perforations 80, which connects the first and second faces to form a channel (see fig.1). The substantially parallel faces are spaced from each other at the third face a distance

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greater than a thickness of the door and the template is configured to mount over a door edge with a slip fit (see fig. 4). The first, second, and third sets of perforations configured to correspond to the position of door fixture mounting holes (see column 1, lines 47-51).

However, Brydon fails to teach a first, second, and third group of one or more lines connecting and identifying the first, second, and third sets of perforations in the template. Nevertheless, Morita et al. teaches a template (1) comprising a group of one or more lines (6, 7) connecting and identifying each of the sets of perforations in the template (see fig.1a, and columns 2 and 3, lines 61-64 and 15-17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the template of Brydon, in view of Morita et al., such that it would provide the template of Brydon with the concept of having lines connecting and identifying each of the sets of perforations for the purpose of more easily distinguishing one set of perforations from another. Furthermore, it would have been an obvious matter of design choice to modify the template of Brydon with the thickness of the template faces being sized to allow the door to move to the closed position with the template mounted on the door edge, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brydon in view of Morita et al. as applied to claim 7 above, and further in view of U.S. Patent No. 5,666,737 to Ryan, III.

Brydon, as modified, discloses the claimed invention except for the perforation diameters are in the range of 1 to 10 millimeters, and the lines including a label. However, Ryan, III teaches a template (10) comprising the perforation diameters are in the range of 1 to 10 millimeters (see column 3, lines 15-16), and the lines including a label (see fig.1, defined by the indicia "37mm Line"). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the template of Brydon, as per the teachings of Ryan, III, such that it would provide the template of Brydon with the concept of the aforementioned limitations for the purpose of providing more easily distinguishable lines and accurately marked holes.

### ***Response to Arguments***

Applicant's arguments filed on August 16, 2006 have been fully considered but they are not persuasive.

In response to Applicant's argument concerning the Brydon reference teaching away from making the faces of the template thin enough to allow the door to close with the template mounted on the door edge. Examiner notes that the Brydon reference discloses the template to have a greater thickness to provide more durability in comparison to a template made of paper (see background of the invention). However, nowhere in the specification does the Brydon reference teach away from providing a

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template thin enough to allow the door to close with the template mounted on the door edge.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, the Morita et al. reference was combined with the Brydon reference to merely teach the concept of having lines connecting and identifying each of the sets of perforations on the template for the purpose of more easily distinguishing one set of perforations from another.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abdelwahed whose telephone number is (571) 272-4417. The examiner can normally be reached Monday through Friday from 10:00 A.M. to 6:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on (571) 272-4475.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the examiner or the examiner's supervisor.

AA  
08/28/2006

  
MONICA CARTER  
SUPERVISORY PATENT EXAMINER